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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/503,604	07/18/95	IMANAKA	R MAT-3720

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EXAMINER

GRANT, C.

ART UNIT PAPER NUMBER

2602

11

DATE MAILED: 01/10/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/15/96

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11,453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-4, 6-15 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-4, 6-11 is/are allowed.

☒ Claim(s) 12-15 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is vague because the limitation "an information on demand system", recited in lines 1-2 is not recited in claims 8-11. Applicant should note that the preamble of claims 8-11 recite "a subscriber apparatus".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Saito.

Considering claim 13, Saito discloses an apparatus for providing information on demand in figure 2. Note the following:

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- a) the claimed receiving step is met by the charging center of fig. 2, which receives a request for information (see col. 4, lines 13-34);
- b) the claimed transmitting information to at least one of a subscriber display and subscriber recording means is met by broadcasting station which transmits information to TV or recorder of fig. 2;
- c) the claimed charging the subscriber for the information is met by the charging performed by the charge center whether or not the subscriber records the information on the recording means.

Considering claim 14, Saito discloses an apparatus for providing information on demand. Note the following:

- a) the claimed receiving means is met by charge center of fig. 2 (see col. 4, lines 13-34);
- b) the claimed sending means is met by broadcasting station of fig. 2;
- c) the claimed charging means is met by charge center of fig. 2, wherein the subscriber is being charged for the information whether or not the information is recorded on the recording means.

Claim 15 is inherent since the subscriber has the ability to selectively, display or record or both display and record a broadcast program.

Allowable Subject Matter

4. Claims 1-4 and 6-11 are allowable over the prior art of record.
5. Claim 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action.
6. The following is an Examiner's statement of reasons for the indication of allowable subject matter:

Claims 1-4 and 6-12 would be allowable because the prior art fails to disclose or suggest an information on demand system comprising a charging means for charging a different amount (or subscriber discriminating means for discriminating) for the case in which the information is provided to a display means, a recording means or to both the display and record means or a subscriber apparatus comprising a recording and terminal control means as recited in the claims.

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Response to Amendment

7. Response to applicant's amendment regarding claims 13-15:
Applicant should note that claims 13 and 14 each recite "charging the subscriber...based on whether or not the information is recorded on the subscriber recording means". This claim limitation is met by Saito because the broadcasting station charges the subscriber for information requested regardless of what the subscriber does with the information. This includes whether or not the information is recorded.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chris Grant whose telephone number is (703) 305-4755. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Peng, can be reached on (703) 308-5461. The fax phone number for this Group is (703) 305-9509.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.



Chris Grant

January 3, 1997